



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Collins et al.
Serial No. : 10/777,820
Filed : February 12, 2004
Title : COBALAMIN CONJUGATES USEFUL AS ANTITUMOR AGENTS

Art Unit : 1654
Examiner : David Lukton
Conf. No. : 5690

MAIL STOP RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Applicants request consideration of the references listed on the attached PTO-1449 form. Under 37 C.F.R. § 1.98 (a)(2)(ii), only copies of foreign patent documents and/or non-patent literature are enclosed. Copies of any listed U.S. patents or U.S. patent application publications can be provided upon request.

Applicants also request the Examiner to review the prosecution, including Office Actions and Applicant Responses, filed in co-pending application U.S. Serial No. 10/028,857 (the "'857 application'"), and in particular, Applicants ask the Examiner to review the '857 application file history for any double-patenting, prior art, or other issues with respect to the present application. Applicants note that the Examiner in the '857 application previously issued (Office Action dated August 24, 2007) an obviousness-type double-patenting rejection over the claims of U.S. Patent No. 6,806,363 (hereinafter, "the '363 patent'"), a patent to which the present application claims priority, in view of Grissom et al. (U.S. Pat. No. 6,905,884) (hereinafter, "Grissom"), and issued other prior art-related rejections. With respect to the

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10/31/2007

Date of Deposit

Meredith Mescher

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MEREDITH MESCHER

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obviousness-type double-patenting rejection, Applicants argued, in a response dated October 24, 2007, that the claims of the '857 application were not anticipated nor rendered obvious by the claims of the '363 patent, Grissom, or any combination thereof. Applicants argued that the compositions of the '857 application require that position G¹ is limited to alkyl, acyl, silyl, phosphate, or L-T (see limitation vii), where T is the residue of one or more molecules of neutron capture agents (see limitation (xii)). In addition, the '857 claims recite a genus of compounds having various substitution possibilities (e.g., R, Z, V, Y, K, E, M moieties) around the cobalamin structure. The '363 claims require that the substitution at G¹ be hydrogen, while Grissom discloses that fluorescent probes could be at this position. In addition, both the '363 patent and Grissom recite a basic cobalamin structure lacking substitutions at any of the various positions proposed in the '857 claims. Thus, the claims of the '857 application were not anticipated by the references. Moreover, the '363 patent and Grissom recite a cobalamin structure having substitutions at only certain positions; see, e.g., Figures 1-3 of '363 and Figures 1-15 of Grissom. Nowhere in the claims of the '363 patent or Grissom references, however, is there a rationale, either stated or unstated, that would prompt one having ordinary skill in the art to modify, in terms of specific chemical structure, the compositions claimed in the '363 patent to result in those as presently claimed (i.e. wherein position G¹ is limited to alkyl, acyl, silyl, phosphate, or L-T (see limitation vii), where T is the residue of one or more molecules of neutron capture agents (see limitation (xii))). Lacking a suggestion of the specific molecular modifications necessary to modify the claimed compositions of the '363 patent to result in those claimed in the '857 application, the cited references fail to render the claims obvious.

This filing is being made with the filing of a Request for Continued Examination. No fee is required.

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Respectfully submitted,

Date: 10/31/02

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